

REMARKS**Summary of the Office Action**

Claims 4, 5, and 7 stand rejected under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent No. 5,982,629 to *Shoji et al.* (“*Shoji*”) in view of U.S. Patent No. 6,297,142 to *Mita et al.* (“*Mita*”).

Summary of the Response to the Office Action

Applicants amend claim 4 to include the features of claim 5, and cancel claim 5 without prejudice or disclaimer. Accordingly, claims 4 and 7 are presently pending.

All Claims Comply With 35 U.S.C. § 103(a)

Claims 4, 5, and 7 stand rejected under 35 U.S.C. § 103(a) as being anticipated by *Shoji* in view of *Mita*. Applicants respectfully traverse the rejection for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

The Office Action has not established a *prima facie* case of obviousness at least because *Shoji* and *Mita*, whether alone or in combination, fail to teach or suggest all the recited features of newly amended independent claim 4. Independent claim 4 recites, in part, “a step of forming an insulating layer after said step of forming a terminal portion in manufacturing said circuit

board, said step of forming an insulating layer being to form an insulating layer in the other area than the area where said terminal portion is formed, wherein said insulating layer is formed so as to cover a peripheral edge of said plated layer so that the surface of said circuit board and at least one of the surface of the base layer are not exposed externally and the insulating layer is made of epoxy resin.” *Shoji* or *Mita*, whether taken alone or in combination, fail to teach or suggest at least these features of claim 4.

Shoji fails to disclose, teach or suggest that the insulating layer is made of epoxy resin. *Shoji* discloses that SiO₂ or SiN is used as the insulating layer. *Shoji* does not employ glass epoxy resin as a circuit board. When an insulating layer made of SiO₂ or SiN (as disclosed in *Shoji*) is provided on a circuit board made of glass epoxy resin (as in the present invention), the insulating layer will peel off from the circuit board due to a weak affinity between SiO₂ and the glass epoxy resin. On the other hand, in the present invention, since epoxy resin is employed as an insulating layer, the insulating layer does not peel off from the circuit board made of glass epoxy resin. Thus, Applicants believe that *Shoji* fails to disclose the technical features of the present invention with respect to epoxy resin provided on glass epoxy resin. Further, the cited reference, *Mita*, fails to disclose that an insulating layer is provided on the circuit board. *Mita* does not cure the deficiency in *Shoji*. Thus, the rejection of claim 4 should be withdrawn.

As pointed out in M.P.E.P. § 2143.03, all the claimed limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. Because *Shoji* or *Mita*, whether taken alone or in combination, fail to teach or suggest each feature of

newly amended independent claim 4, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Claim 7 depends from independent claim 4. Accordingly, claim 7 is also allowable because of the additional features it recites and the reasons stated above. In view of the above, the present invention is patentable over the combination of *Shoji* and *Mita*.

CONCLUSION

In view of the foregoing, Applicants respectfully request entry of the amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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